

Appl. No. 09/738,456

Amdt. dated March 5, 2004

Reply to Office Action of December 08, 2003

AFTER FINAL EXPEDITED PROCEDURE

REMARKS

Claims 1, 3 to 7, 9 to 19, 21 and 23 were pending in the application at the time of examination. Claims 1, 4, 5, 7, 10, 11, 13, 14, 16, 17, 19, 21 and 23 stand rejected as anticipated. Claims 3, 6, 9, 12, 15, and 18 stand rejected as obvious.

Claims 1, 7, 13, 19, 21 and 23 are amended. As explained more completely below, each amendment simply recites a feature that was inherent in the original claim language when the claim language was interpreted in view of the specification, as required by the MPEP. Accordingly, the amendments do not require a new search or consideration of new issues. The amendments were not earlier presented, because they are in response to the Examiner's comments that were first presented in the Final Office Action. While Applicants disagree with the Examiner's comments, Applicants submit that the amendments clarify the language in the claims and more clearly place the application in a condition for allowance. Accordingly, entry of the amendments is respectfully requested. If the Examiner should disagree, entry of the amendments is requested so as to narrow the issues for appeal.

Independent Claims 1, 7, 19, 21, and 23 stand rejected as anticipated by U.S. Patent No. 6,393,429, hereinafter Yagi. The Examiner cited Figures 9(A) and 9(B) of Yagi and stated in part:

However, it is understood that the ordinary folder tree is displayed regardless ... it is displayed by default. As shown in figure 9(B), the folder tree is a hierarchical list of all the folders and files on the user's computer. (Emphasis added.)

In the Examiner's comments in the final office action, the Examiner contends that "list" as recited in the Claims reads on a "hierarchical list," and the Examiner cited to three patents

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to support this contention. However, the references show that those of skill in the art do not read "list" as "hierarchical list."

The reason is that in each instance, the reference does not say "list" but instead adds an adjective to "list" to define a relationship between the objects in the list, i.e., specifies a particular type of list, "a hierarchical list." The Examiner's evidence demonstrates that "list" does not imply a hierarchical structure and if those of skill want to imply such a structure, they state "hierarchical list," and not "list" by itself.

Particularly, U.S. Patent No. 6,606,105 B1 at lines 25 and 26 stated "... the objects are stored in a tree-like data structure that is represented graphically in a **hierarchical list**." (Emphasis added.) U.S. Patent No. 6,584,507 B1 at line 6 stated "... control tree is a **hierarchical list**..." (Emphasis added.) U.S. Patent 5,977,971 in the Abstract stated "The tree view control enables an application program to display a **hierarchical list** of items." (Emphasis added.) In each instance, the patent used "hierarchical" to modify "list."

The reason is that "list" without more does not imply any relationship among the objects. The definition in Webster's Ninth New Collegiate Dictionary (1983) for the noun "list" is:

1 a: a simple series of words or numerals (as the names of persons or objects) <a guest ~> . . .

Thus, according to the dictionary, "list" has no specified relationship between the elements. This is why to specify a relationship of the items in a list, those of skill use "hierarchical" to define the relationship between the items in the list.

The Examiner and all the references used by the Examiner are consistent with this interpretation. Therefore, when the Examiner equates "list" with "hierarchical list," the Examiner

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is reading a limitation into the claim because the reference used in the rejection and the references used to interpret that reference all use the terms in a consistent matter. The usage contradicts the Examiner's interpretation. To add a particular organization to a list, the cited prior art demonstrated that it is necessary to add a term that defines the structure, and without such a term, no organization is implied by "list," as shown in the dictionary definition.

To render this point moot and move the prosecution forward, Applicants have incorporated an inherent property of the list as defined in the specification at page 8, line 35 to page 9, line 5. This amendment does not require either consideration of new issues nor a new search because it simply gives meaning to "list" in terms of the present disclosure. The amendment makes clear that "list" does not include any defined relationship among the elements of the list as in Yagi et al.

Since the portion of Yagi as previously noted teaches a hierarchical relationship on specific partitions, Yagi fails to satisfy the following requirement from the MPEP:

**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference....."The identical invention must be shown in as complete detail as is contained in the ... claim... The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP §2131, 8th Edition, Rev. 1, p 2100-70 (Feb. 2003)

Yagi fails to teach the "identical invention . . . in as complete detail as is contained in the Claim," as required by the MPEP, because the "hierarchical list" teaches away from the

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element recited in Applicants' claims. Applicants respectfully submit that the anticipation rejection is not well founded. Applicants request reconsideration and withdrawal of the anticipation rejection of Claims 1, 7, 19, 21, and 23 and the claims dependent thereon.

With respect to the anticipation rejection of Claim 13, the Examiner's very rejection demonstrates that the reference fails to teach as required by the MPEP. The Examiner stated in continuing the rejection,

Thus upon a first action on this "Browse" button, this first action specifically being the selection of the "Browse" button and the subsequent selection of a folder in the resulting folder tree screen, the contents of a directory are displayed in a directory content window.

The rejection shows that two actions are required to achieve the same result that is achieved in a single action in Applicants' invention, i.e., "upon a first action on said file navigation icon, contents of a directory are displayed in said directory content window in response to the first action." Therefore, based upon the above quotation from the MPEP, Yagi fails to anticipate Claim 13. Applicants request reconsideration and withdrawal of the anticipation rejection of Claim 13 and the claims dependent thereon.

Claims 3, 6, 9, 12, 15 and 18 stand rejected as being obvious in view of Yagi taken with U.S. Patent No. 6,370,549. Assuming that the combination of references is correct, the additional information relied upon by the Examiner from the secondary reference fails to overcome the basic deficiency of Yagi as noted above with respect to the independent Claim. Accordingly, Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 3, 6, 9, 12, 15 and 18.

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Claims 1, 3 to 7, 9 to 19, 21, and 23, remain in the application. Claims 1, 7, 13, 19, 21 and 23 are amended. Claims 2, 8, 20, 22, and 24 were previously canceled. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).


CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on the date shown below.

Respectfully submitted,



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March 5, 2004
Date of Signature